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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/365,426 08/02/99 HARTMAIER

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EXAMINER

TM02/1002

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ART UNIT	PAPER NUMBER
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2164
DATE MAILED:

10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/365,426

Applicant(s)
Hart Maler

Examiner
Daniel Felten

Art Unit
2164



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Aug 2, 1999

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-28 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4

20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1
2
3 1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form
4 the basis for the rejections under this section made in this Office action:

5 A person shall be entitled to a patent unless --

6 (e) the invention was described in a patent granted on an application for patent by another filed in the United
7 States before the invention thereof by the applicant for patent, or on an international application by another who
8 has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
9 thereof by the applicant for patent.

10 2. Claims 1, 2, 5, 6, 16, 20 and 21 are rejected under 35 U.S.C. 102(e) as being
11 anticipated by Dorf (US 6,000,608).

12 13 As in claim 1:

14 Dorf discloses a method for replenishing prepaid accounts comprising the steps of: receiving
15 cash or equivalent from a consumer; receiving a prepaid account identification from the
16 consumer; and processing a replenishment transaction wherein a cash value is added to a prepaid
17 account associated with the prepaid account identification, and wherein said prepaid account is
18 not associated with a merchant receiving said cash or equivalent (see Dorf, whole section
19 *Electronic Gift Certificate Card (EGC)*, col. 7, ll. 34 to col. 9, ll. 25; and col. 11, ll. 39+).

As in claim 2:

Dorf discloses swiping the prepaid account card through an authorization terminal (see Dorf, col. 7, ll. 34 to col. 9, ll. 25; and col. 11, ll. 39+).

As in claim 5:

Dorf discloses a method for replenishing prepaid accounts comprising the steps of: providing access to a replenishment system via a computer network; receiving a user identification (PIN); receiving a replenishment amount from the user; processing a replenishment transaction, wherein funds equivalent to the replenishment amount are credited to a prepaid account selected by said user (see Dorf, col. 7, ll. 34 to col. 9, ll. 25; particularly col. 8, ll. 3-6).

As in claim 6:

Dorf discloses that the user identification comprises a prepaid account number (see Dorf, col. 7, ll. 34 to col. 9, ll. 25; particularly col. 7, ll. 50-62).

As in claim 16:

Dorf discloses a computer program product having computer readable medium with computer program logic recorded thereon for use in a system replenishing prepaid accounts, the computer

1 program product comprising: means for receiving real time data from a bank, wherein the data
2 comprises information related to a replenishment transaction; means for identifying a prepaid
3 account from said data; and means for sending a message to a prepaid engine, wherein said
4 update message comprises information regarding an amount of money to be added to said
5 prepaid account (see Dorf, *software system* 108, col. 8, ll. 17-21; and col. 11, ll. 16-37; see *add*
6 *value in real-time*, col. 9, ll. 62 to col. 10, ll. 6; see card for use in *banking network*, col. 15, ll.
7 66 to col. 16, ll. 2; see *message protocol* col. 10, ll. 66 to col. 11, ll. 32)

8
9 **As in claim 20:**

10 Dorf discloses wherein the bank is a banking institution (see Dorf, col. 11, ll. 16+; col. 13, ll.
11 16-30).

12
13 **As in claim 21:**

14 Dorf discloses wherein the bank is an entity that supports financial transactions over a point of
15 sale network (see Dorf, col. 13, ll. 16-30).

1
2 3. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller (WO
3 98/47112).

4
5 **As in claim 7:**

6 Miller discloses a method for replenishing prepaid accounts comprising the steps of receiving a
7 string of dialed digits from a wireless telephone; identifying a feature code from said dialed
8 digits, wherein said feature code corresponds to a replenishment transaction; creating a
9 replenishment transaction message from said dialed digits; and sending said replenishment
10 transaction message to a replenishment system (see Miller pages 22 and 23).

11
12 **As in claim 8:**

13 the step of providing a confirmation message to said wireless telephone indicating whether a
14 replenishment transaction was completed by said replenishment system (see Miller pages 22 and
15 23).

16
17 **As in claim 9:**

18 the confirmation message is sent via a Short Message Service (SMS) (see Miller pages 22 and
19 23).

1
2 4. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al
3 ('Walker', US 6,246,755 B1).

4
5 Walker, as in claim 22, discloses a method for replenishing prepaid accounts comprising
6 the steps of:
7 receiving, at a voice response unit, calls from users desiring to replenish said prepaid accounts;
8 identifying each of the users;
9 prompting the users to select replenishment amounts; and
10 processing replenishment transactions by causing the transfer of the replenishment
11 amounts from a designated source account to the prepaid accounts (see Walker, fig. 6, col. 7, ll.
12 52 to col. 8, ll. 9).

13
14 **As in claim 24:**

15 the method of claim 22 wherein the identifying step further comprises:
16 determining the users' telephone number using a calling line identification function; and
17 prompting the users for personal identification number (see Walker, fig. 6, col. 7, ll. 52 to col. 8,
18 ll. 9).

1 **As in claim 25:**

2 Further comprising the step of: prompting the users to select the designated source account (see
3 Walker, fig. 6, col. 7, ll. 52 to col. 8, ll. 9).

4
5 **As in claim 26:**

6 further comprising the step of: identifying the designated source account from a preconfigured
7 user profile associated with the identified user (see Walker, fig. 6, col. 7, ll. 52 to col. 8, ll. 9).

8
9
10 ***Claim Rejections - 35 USC § 103***

11 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
12 obviousness rejections set forth in this Office action:

13 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
14 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
15 such that the subject matter as a whole would have been obvious at the time the invention was made to a person
16 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
17 manner in which the invention was made.

18 6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf.

19
20 Dorf discloses A method of providing prepaid account replenishment services comprising
21 the steps of receiving real time data from a bank, wherein the data comprises information related
22 to a replenishment transaction;

1 identifying a prepaid account number from said data;
2 sending an update message to a prepaid engine, wherein said update message comprises
3 information regarding an amount of money to be added to said prepaid account; and
4 sending a disbursement message to the bank, wherein the disbursement message
5 comprises information regarding the distribution of funds associated with said replenishment
6 transactions (see Dorf, *software system* 108, col. 8, ll. 17-21; and col. 11, ll. 16-37; see *add*
7 *value in real-time*, col. 9, ll. 62 to col. 10, ll. 6; see card for use in *banking network*, col. 15, ll.
8 66 to col. 16, ll. 2; see *message protocol* col. 10, ll. 66 to col. 11, ll. 32).

9 Dorf fails to disclose receiving summary data from the bank, wherein the summary data
10 comprises information related to a plurality of replenishment transactions; reconciling individual
11 replenishment transactions by comparing the real time data with the summary data
12
13

14 7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over
15 Hayashida (US 6,257,487).
16

17 **Regarding claim 3:**

18 Hayashida discloses a method for replenishing accounts comprising the steps of
19 receiving a bank IC card from a user at an Automated Teller Machine (ATM);
20 displaying a menu of financial transaction options to said user on a display at said

1 ATM, wherein one of said financial transaction options is a prepaid account replenishment
2 transaction; and

3 processing a prepaid account replenishment transaction when such an option is
4 selected by said user.

5 Hayashida fails to disclose replenishing prepaid accounts, comprising steps of receiving a
6 bank *debit* card from a user at an ATM. However, since prepaid debit cards, credit cards,
7 electronic wallets, et al., are all notoriously old and well known within the art to make electronic
8 transactions in place of cash, it would have been obvious to an artisan at the time of the
9 invention to substitute one of the aforementioned cards for Hayashida's multifunction card
10 because an artisan at the time of the invention would have viewed Hayashida's card as an art
11 recognized equivalent to a debit card/credit card/etc. inasmuch as the cards have the capacity to
12 carry out electronic (or magnetic or optical) transmission of financial data through a banking
13 system. Thus, to substitute one card for another (Hayashida's card for a debit card) in this case,
14 would constitute an obvious matter of design choice, to one of ordinary skill in the art.

15
16 **As in claim 4:**

17 Hayashida discloses prompting the user to select a replenishment transaction amount; and
18 prompting the user to select a account to be replenished (see Hayashida, col. 6 , ll. 21+).

1 8. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller
2 (WO 98/47112) in view of Taskett (WO 98/25237).

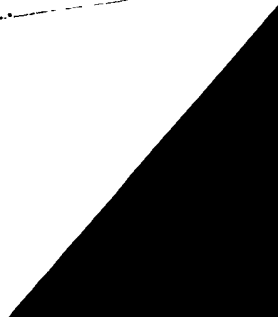
3
4 **Regarding claim 10:**

5 Miller discloses a all the limitations within the claimed invention except he fails to mention that
6 the wireless telephone prepaid services have services associated with an account.

7 Taskett discloses a system which provides prepaid account services to consumers (see
8 Taskett, Abstract). Accounts are inherently associated with any user that makes a transaction
9 whereby information or funds are acquired from a remote location and authentication is used to
10 verify the identification of the user before the transmission of funds. Therefore, it would have
11 been obvious to employ the prepaid account found in Taskett to Miller because an artisan of
12 ordinary skill in the art at the time of the invention would have recognized the need to identify
13 the user associated with the medium in order to make remote replenishment transactions.

14
15
16 **As in claim 11:**

17 Miller in view of Taskett discloses communicating with the banking network step further
18 comprises the steps of: receiving transaction messages following individual replenishment
19 transactions by said consumers; receiving a reconciliation message summarizing sub-
20 individual transactions that occurred during a certain period; reconciling said individ-



1 transactions; and sending a message indicating the disbursement of funds associated with the
2 replenishment transactions (see Miller pages 22 and 23).

3
4
5
6
7 **As in claim 12:**

8 Miller in view of Taskett discloses the communicating with the prepaid engine further comprises
9 the step of sending a message indicating an amount to be added to a particular prepaid account
10 (see Miller pages 22 and 23).

11
12 **As in claim 13:**

13 Miller in view of Taskett bank is a banking institution (see Miller, Abstract and pages 22 and
14 23).

15
16 **As in claim 14:**

17 Miller in view of Taskett bank is an entity that supports financial transactions over a point of
18 sale network (vending machine) (see Miller page 6).

19
20 **As in claim 17:**

1 The computer program product of claim 16 further comprising: means for receiving summary
2 data from said bank, wherein said summary data comprises information related to a plurality of
3 said replenishment transactions (see Dorf, col. 8, ll. 5+).

4
5 **As in claim 18:**

6 The computer program product of claim 17 further comprising:
7 means for reconciling individual replenishment transactions by comparing said real time
8 data with said summary data (see Dorf col. 8, ll. 23+).

9
10 **As claim 19:**

11 The computer program product of claim 16 further comprising:
12 means for sending a disbursement message to said bank, wherein said disbursement message
13 comprises information regarding the distribution of funds associated with said replenishment
14 transactions (see Dorf, col. 10, ll. 65-67).

15
16 **Regarding claims 23, 27 and 28:**

17 The applicant cites wireless network is used for replenishing prepaid card accounts.
18 Replenishment of calling cards accounts are notoriously old and well known in wire and cellular
19 telephone networks. Therefore, OFFICIAL NOTICE is taken of replenishment of prepaid card
20 accounts in cellular phone networks. The use of a wireless network would be an obvious

1 extension of the teachings of Walker et al inasmuch as an artisan of ordinary skill in the art
2 would recognize the advantages of wide spread use of the cellular telephone industry and would
3 have sought the use of the replenishing method for increasing the system in both wired and
4 wireless networks.

5
6
7 ***Conclusion***

8 9. A list of cited references appears below not relied upon in this Office Action:

9 Resnick et al (US 6,185,545 B1) discloses a electronic payment system

10 Hayashida (US 5,644,118) discloses an electronic cashless system

11 Taskett (US 6,115,458) discloses a method and apparatus for summaries of prepaid instrument
12 activity.

13 10. Any inquiry concerning this communication or earlier communications from the examiner
14 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
15 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.

16 Any inquiry of a general nature relating to the status of this application or its proceedings should
17 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
18 ***Vincent Millin*** whose telephone number is (703) 308-1065.

19
20 11. Response to this action should be mailed to:
21

22 Commissioner of Patents and Trademarks

23 Washington, D.C. 20231

1
2 for formal communications intended for entry, or (703) 305-0040, for informal or draft
3 communications, please label "Proposed" or "Draft".

4 Communications via Internet e-mail regarding this application, other than those under 35
5 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
6 addressed to *[daniel.felten@uspto.gov]*.

7 All Internet e-mail communications will be made of record in the application file. PTO
8 employees do not engage in Internet communications where there exists a possibility that
9 sensitive information could be identified or exchanged unless the record includes a properly
10 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
11 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
12 Trademark on February 25, 1997 at 1 195 OG 89.

13
14
15 

16 Daniel S. Felten
17 September 19, 2001


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100